

App. No. 10/007, 364  
Office Action Dated July 19, 2005

### **REMARKS**

Reconsideration is requested in view of the above amendments and the following remarks. Claim 20 and 35 are amended. New claim 36 is added. The amendments and new claim are supported by the original disclosure, for example, Figures 4A and 4B and page 8, lines 16-22. Claims 10-23, 25 and 29-36 are pending.

#### **I. Claims 20, 21, 23, 34 and 35**

In the Advisory Action mailed January 9, 2006, the examiner advised that claims 20, 21, 23 and 34 would continue to be rejected under 35 USC 102(b) as being anticipated by Shimuzu et al. (US 4,841,949). Applicant respectfully traverses this rejection.

Shimuzu et al. do not disclose each and every feature recited in claim 20. For example, Shimuzu et al. do not disclose a shaft wherein over at least the majority of the length of the shaft the width dimension is greater than the thickness dimension.

Shimuzu et al. disclose a bending portion 12 that is round in cross-section so that at best the bending portion has a width that is equal to the thickness dimension. Although Shimuzu et al. disclose a distal end portion 14 with an opening 60 in it, the width dimension is not greater than the thickness dimension over at least the majority of the length of the bending portion 12.

For at least this reason, claim 20 is patentable over Shimuzu et al. Claims 21, 23 and 34 depend from claim 20 and are patentable along with claim 20 and need not be separately distinguished at this time.

In the Advisory Action mailed January 9, 2006, the examiner also advised that claim 35 would also be rejected under 35 USC 102(b) as being anticipated by Shimuzu et al. (US 4,841,949). Applicant respectfully traverses. Shimuzu et al. do not disclose an exterior surface of the shaft, which has at least two exit ports for the lumens defined in the surface, as recited in claim 35. Shimuzu et al. disclose a single opening 60 of a storage room defined in the exterior surface of the bending portion. Shimuzu et al. does not disclose a plurality of exit ports in an exterior surface.

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II. Claims 16-18, 32 and 33

In the Advisory Action mailed January 9, 2006, the examiner also advised that claims 16-18, 32 and 33 would continue to be rejected under 35 USC 103(a) as being unpatentable over Shimizu et al. Applicant traverses this rejection.

Shimizu et al. disclose an endoscope used for general medical purpose. Shimizu et al. do not disclose and teach that the endoscope is used anywhere close to the heart. Therefore, Shimizu et al. do not teach and suggest that the distal end 14 is configured to lie within an atrioventricular valve groove of the heart.

Further, Shimizu et al. do not disclose an exit port spaced inwardly from the distal end by a distance in the range from 0.5 cm to 5 cm. Claim 16 is directed to a device for closing a left atrial appendage of a heart, where the distal end is configured to lie within an atrioventricular valve groove of the heart. Because the distal end lies within the groove, the exit port needs to be spaced a sufficient distance away from the distal end in order for the exit port to be adjacent to the left atrial appendage (see page 8, lines 20-22 of the specification).

Shimizu et al. do not disclose the distance between their distal end and their opening 60. There is no mention of distances in Shimizu et al. or any indication that the drawings are to scale that would lead one to conclude that Shimizu et al. inherently discloses the claimed distances.

Nor does Shimizu et al. provide motivation to use a distance between its distal end and an exit port as claimed. Shimizu discloses an endoscope for general medical treatment. There is no disclosure that the endoscope is useable to close a left atrial appendage, and there is no disclosure that the distal end is configured to lie within an atrioventricular valve groove of the heart. Therefore, there would be no teaching or suggestion to a person having ordinary skill in the art to configure the endoscope such that an exit port of a lumen is spaced inwardly from the distal end by a distance in the range from 0.5 cm to 5 cm, so that the exit port is spaced sufficiently away from the distal end when the distal end is inserted within an atrioventricular valve groove of the heart in order for the exit port to be adjacent to the left atrial appendage.

For at least these reasons, claim 16 is patentable over Shimizu et al. Claims 17 and 18 depend from claim 16 and are patentable along with claim 16 and need not be

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separately distinguished at this time. Applicants do not concede the propriety of the rejections to claims 16-18.

It is Applicants understanding from the Advisory Action that claims 32 and 33 would continue to be rejected under 103(a) as being unpatentable over Shimuzu et al., in view of Whayne et al. (US 5,865,791). Applicant traverses this rejection. Claims 32 and 33 depend from claim 16 and are patentable along with claim 16 and need not be separately distinguished at this time. Applicants do not concede the propriety of the rejections to claims 32 and 33.

Claim 19 is objected to as being dependent upon a rejected base claim. It is patentable along with claim 16 and need not be separately distinguished at this time.

The applicant notes that the Advisory Action did not indicate whether the 35 U.S.C. 112, second paragraph, rejection in the Office Action mailed July 19, 2005 rejecting claims 21 and 23 has been overcome. Applicants will assume that this rejection has been overcome.


In addition, as the Applicants noted in the December 16, 2005 Amendment and Response, the Applicants filed an Information Disclosure Statement on February 4, 2005 (citing a single reference). Applicants request consideration of that Information Disclosure Statement and return of Form 1449 with the reference initialed as being considered, or else an indication from the Examiner as to the status of that Information Disclosure Statement.

In view of the above, favorable reconsideration in the form of a notice of allowance is respectfully requested. Any questions regarding this communication can be directed to the undersigned attorney, James A. Larson, Reg. No. 40,443, at (612) 455-3805.

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Dated: January 18, 2006

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